

REMARKS

Upon entry of this amendment, claims 2, 4, 7, 9-10, 13-16, 19, 22, 25, 27-28, 31, 33, 34, 46 and 49-50 will be amended, claims 38-41 will be canceled, and claim 52 will be added. As a result, claims 1-37 and 42-52 will remain pending in the application. These amendments have been made solely to expedite prosecution of the present application, and Applicants reserve the right to pursue the subject matter of the original claims in this application and in other applications. No new matter has been added.

The pending claims stand rejected under 35 USC 102 and/or 103 as being unpatentable over US Patent No. 5,831,531 ("Tuttle") and/or various other references as described below. Applicants respectfully request reconsideration of these rejections in view of the following remarks.

The References Do Not Disclose or Suggest "Arranging for Ownership of [an] Item to be Transferred Based on [an] Indication" That a Container Has Been Opened

Claims 1-15 and 17-20 recite that an indication is received "that [a] container has been opened." Moreover, the claims recite "arranging for ownership of the item to be transferred based on the indication."

By way of example, a customer might take physical possession of a package that contains a printer toner cartridge (e.g., he or she might bring the package home). Legal ownership of the printer toner cartridge, however, may remain with another party, such as a retailer or a manufacturer. When the customer eventually opens the package (e.g., by opening a box or tearing a pouch), an indication may be transmitted. Based on the indication, it may be arranged for ownership of the item to be transferred to the customer.

Tuttle is directed to an anti-theft system to protect containers, such as suitcases. If a suitcase is opened (e.g., by an unauthorized airport employee), a circuit in the suitcase is broken and a signal is transmitted. Based on the transmitted signal, an alarm is generated and/or appropriate security employees are alerted.

Nothing in Tuttle addresses a transfer of ownership of an item as recited in these claims.

According to the Office Action, this element is disclosed in FIG. 6A and at col. 4, lines 12-25. FIG. 6A is a picture of a suitcase handle. For convenience, col. 4, lines 12-25 are reproduced here:

FIG. 5 is a functional block diagram showing a method of communication between several RFID tags and an interrogation unit in light of the anti-theft detection units later described in FIGS. 6 and 7. Referring now to Figure 5, Host/CPU 51 interacts with interrogator/transceiver unit 52 and instructs unit 52 to interrogate RFID tags A (53) and B (54) for alarm data. If interrogator 52 receives no reply from either tag A or tag B the host 51 continues to instruct unit 52 to interrogate tags A and B as often as internal software demands it. However, if tag A responds (in an alarm state) the interrogator unit 52 communicates that information to the host 51 and an appropriate alarm is sounded to notify personnel that unauthorized opening of a container has just taken place.

That is, an alarm is generated when the suitcase is opened. The ownership of the suitcase, or of any items in the suitcase, is not transferred (either to security personnel or to the person who opened the suitcase without authorization).

Because Tuttle completely fails to disclose or suggest this feature, reconsideration of these rejections is respectfully requested.

The References Do Not Disclose or Suggest "Arranging for Another Item to be Provided Based on (an) Indication" That a Container Has Been Opened

Claims 21-28 recite "arranging for another item to be provided based on the indication." By way of example, when a customer eventually opens a package that contains a printer toner cartridge, a manufacturer might ship another package to the customer (*e.g.*, via Federal Express).

Nothing in Tuttle addresses providing another item as recited in these claims.

According to the Office Action, this element is disclosed at col. 4, lines 18-21. For convenience, col. 4, lines 18-21 are reproduced here:

If interrogator 52 receives no reply from either tag A or tag B the host 51 continues to instruct unit 52 to interrogate tags A and B as often as internal software demands it.

That is, a periodic check is made to determine if the suitcase has been opened without authorization. Another suitcase is not provided to any party - nor is another item in any suitcase provided to any party. Applicants respectfully do not understand the rejection.

Because Tuttle completely fails to disclose or suggest this feature, reconsideration of these rejections is respectfully requested.

The References Do Not Disclose or Suggest Arranging for Another Item to be Provided "After a Pre-Determined Number of Indications Are Received"

Claims 23 recites that it is arranged for another item to be provided "after a pre-determined number of indications are received." Consider, for example, a customer who purchases a thirty-day supply of disposable contact lenses. In this case, another thirty-day supply might be shipped to the customer after twenty indications have been received (because at that point the customer would only have a ten-day supply remaining).

Nothing in Tuttle addresses providing another item after a pre-determined number of indications are received as recited in this claim.

According to the Office Action, this element is disclosed at col. 4, lines 18-25. For convenience, col. 4, lines 18-21 are reproduced here:

If interrogator 52 receives no reply from either tag A or tag B the host 51 continues to instruct unit 52 to interrogate tags A and B as often as internal software demands it. However, if tag A responds (in an alarm state) the interrogator unit 52 communicates that information to the host 51 and an appropriate alarm is sounded to notify personnel that unauthorized opening of a container has just taken place.

That is, an alarm is generated when the suitcase is opened. No other item is provided to any party after a pre-determined number of indications have been received. For example, the alarm is not generated after a suitcase has been opened five times without authorization. Nor would such a feature make any sense in Tuttle.

Because Tuttle completely fails to disclose or suggest this feature, reconsideration of these rejections is respectfully requested.

The References Do Not Disclose or Suggest a "Consumable Item" or a "Disposable Package"

Claim 16 recites a "consumable item" and a "disposable package." For example, copy paper might be provided in a wrapper. According to the Office Action, claim 16 stands rejected under 35 USC 103 as being unpatentable over Tuttle in view of Blomqvist. Moreover, according to the Office Action these elements were discussed with respect to claims 1 and 11. Applicants respectfully do not understand, and request allowance of claim 16.

The References Do Not Disclose or Suggest That a Signal is not Transmitted "If a Pre-Determined Number of Other Containers are Present"

Claim 51 recites that a signal indicating that a container has been opened is not transmitted "if a pre-determined number of other containers are present." For example, a customer might purchase ten reams of copy paper. As each ream is opened, a transmitter associated with that ream may determine how many other reams are present (*e.g.*, via a short-distance wireless communication). When a ream determines that only two other reams are present, an indication may be provided (so that another ten-reams of paper can be shipped to the customer).

According to the Office Action, this element is described at col. 1, lines 54-57. For convenience, col. 1, lines 54-57 are reproduced here:

Simply, if continuity is disabled by a forced entry of the container, electrical detection means, such as a radio-frequency-identification (RFID) transceiver tag (or simply RFID tag), will alert the owner or monitoring station.

That is, an alarm is generated when the suitcase is opened. No determination is made as to how many other suitcases are in the area. Nor would such a feature make any sense in Tuttle.

Because Tuttle completely fails to disclose or suggest this feature, reconsideration of these rejections is respectfully requested.

The References Do Not Disclose or Suggest "Arranging for a Party to Provide Payment in Exchange for the Item Based on the Indication" or "Providing the Container to a Party Without Receiving Payment in Exchange for the Item"

Claims 3-4 recite "arranging for a party to provide payment in exchange for the item based on the indication." Claims 11-13 recite "providing the container to a party without receiving payment in exchange for the item." Claim 16 recites similar limitations.

By way of example, a customer might take physical possession of a package that contains a printer toner cartridge without providing payment to a retailer (*e.g.*, he or she might bring the package home). When the customer eventually opens the package, an indication may be transmitted. Based on the indication, it may be arranged for the customer to provide payment for the cartridge (*e.g.*, via his or her credit card number).

US Patent No. 5,859,415 ("Blomqvist") is directed to a system that wirelessly communicates with vehicles to arrange for the payment of tolls (*e.g.*, similar to an EZ-Pass system). Blomqvist also discloses the use of a debit card.

Applicants believe that neither Tuttle nor Blomqvist discloses or suggests arranging for a party to provide payment "in exchange for [an] item" ("item" is exchanged in either reference). Applicants also do not believe that either reference discloses arranging for a payment "based on [an] indication" that a container has been opened.

The teaching or suggestion to make the claimed combination must be found in the prior art, and not based on the Applicants' disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The fact that references can potentially be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP 2143.01; In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH, 45 USPQ 2d 1977, 1981-82 (Fed. Cir. 1998) (the question to be asked is "whether the prior art contains a suggestion or motivation to combine references").

As will be explained, there is no motivation in the prior art to modify or combine these references as proposed by the Examiner.

According to the Office Action, it would have been "obvious to one of ordinary skill in the art at the time the invention was made to employ the teaching of Blomqvist in the system of Tuttle because it would be more convenient to make a payment through wireless transmission of radiowaves." The advantages associated with arranging for payment after the customer has opened the container include, for example, increasing the number of items a customer might bring home at one time or receive in one shipment (*e.g.*, because he or she does not need to pay for the items until the container is opened) and reducing the amount of inventory that needs to be stored by a retailer. Neither reference is even remotely associated with these ideas.

If the suitcase disclosed in Tuttle is considered an "item" as recited in these claims, payment for the item would presumably be made when the airline customer purchased the suitcase. If transportation of the suitcase by an airline is considered an "item" as recited in these claims, payment for the item would presumably be made when the airline customer purchased his or her ticket. It simply would not make sense to modify Tuttle such that payment is made when a suitcase is opened without authorization.

Because there is no teaching or suggestion to modify the references in this way, a *prima facie* case of obviousness has not been established and the rejection of these claims should be withdrawn.

The References Do Not Disclose or Suggest That a Signal is Not Transmitted "When the Container is Subsequently Re-Opened"

Claim 6 recites that a signal generated by a remote transmitting device (*e.g.*, when a container is initially opened) is not transmitted "when the container is subsequently re-opened." Claims 44-51 includes similar limitations. By way of example, a signal might be transmitted when a customer initially opens a box that contains thirty-day supply contact lenses - but not when he or she re-opens the box the following day.

According to the Office Action, US Patent No. 6,507,275 ("Romano") discloses such an element at col. 4, lines 18-37. For convenience, col. 4, lines 18-37 are reproduced here:

Warning unit 26 is capable of generating an alert signal indicating when a medicament is to be taken. Warning unit 26 has an interface connector 31 which may be plugged into a plurality of conductors 32 on microprocessor 20. Additionally, warning unit 26 may also be connected to microprocessor 20 via a link between device connection port 33 and data link interface 25. In both respects, warning unit 26 will be able to communicate with microprocessor 20 and function in accordance with the data stored in microprocessor 20. Linking microprocessor 20 to warning unit 26 will produce a united device that possesses the combined functions and capabilities of both the microprocessor 20 and warning unit 26. Warning unit 26 could be used in nursing homes or other locations where a caregiver is available to a patient and may be alerted by the signal generated by warning unit 26. Upon being alerted, the caregiver can immediately attend to the patient and administer the appropriate medicament. The alert signal generated by the warning unit 26 can be a wireless transmission signal 35 sent to a mobile or stationary receiver or an audible alarm. Additionally, the warning unit could generate and send a signal to data output port 34, which could be wired to a stationary alerting unit located at the patient's bed or near the attending staff.

Applicants respectfully do not understand how this passage discloses that a signal is not transmitted when a "container is subsequently re-opened."

The References Do Not Disclose or Suggest "Determining Item Quality Information Based on [an] Indication" That a Container Has Been Opened

Claims 29-34 recite "determining item quality information based on" an indication that a container has been opened. For example, it might be determined that the quality of a roll of photographic film has degraded because a pouch that contains the roll was opened two months ago.

US Patent No. 5,798,694 ("Reber") is directed to a system that determines a food quality based on a sensor in a food container (*e.g.*, a thermometer) or based on how long the food container was removed from a refrigerator.

According to the Office Action, "it would have been obvious to the skilled artisan to use the teaching of Reber et al. in the system of Tuttle for monitoring the condition of the item which is an advantage."

"That an inventor has probed the strengths and weaknesses of the prior art and discovered an improvement that escaped those who came before is indicative of unobviousness, not obviousness." Fromson v. Anitec Printing Plates, Inc., 45 USPQ 2d 1269, 1276 (Fed. Cir. 1997), cert. denied, 119 S. Ct. 56 (1998). By providing embodiments in which an item quality may be determined in accordance with when a container was opened, Applicants have addressed several problems of the prior art (e.g., to help ensure the quality of items that degrade after being opened). The mere fact that embodiments of the present invention provide an advantage does not make them unpatentable.

"[T]he suggestion to combine requirement is a safeguard against the use of hindsight combinations to negate patentability." In re Rouffet, 47 USPQ2d 1453 (Fed. Cir. 1998). The absence of any motivation in the prior art references to determine an item quality based on when a container was opened indicates that the Examiner has simply recognized a benefit provided by the present invention, and then used that benefit as a motivation to combine the references – the essence of impermissible hindsight reconstruction.

The References Do Not Disclose or Suggest "Determining Item Warranty Information Based on the Indication" or That the Warranty Information is Associated with "a Return Policy"

Claims 35- 37 recite "determining item warranty information" based on an indication that a container has been opened. Claim 37 further recites that the warranty information is associated with a "return policy." For example, a first party might purchase a box containing a television and give the box to a second party as a gift two months later. When the second party opens the box, an indication may be provided. As a result of the indication, warranty information might be determined at that time. For example, the second party may be allowed to return a defective television to a retailer within seven days after he or she opened the box.

According to the Office Action, Reber discloses such an element at col. 5, lines 33-38. For convenience, col. 5, lines 33-38 are reproduced here:

The second embodiment can be utilized to monitor for a discard condition of a food item when a temperature sensor is not included in the food storage apparatus 22. An alert indication can be generated if the time duration exceeds a predetermined time

duration. Using the aforementioned rule of the thumb, the predetermined time duration can be selected to be about 2 hours.

For example, it might be determined that a container of milk should be discarded if it has been outside of a refrigerator for more than two hours. Applicants respectfully do not understand how this passage discloses anything about "warranty information" or a "return policy."

The References Do Not Disclose or Suggest "Recording the Indication as an Acceptance of an Agreement Associated With the Item"

Claims 42-43 recite "recording [an] indication [that a container has been opened] as an acceptance of an agreement associated with the item." For example, a customer might purchase a Compact Disc (CD) that contains a computer program. The CD may be sealed in an envelope with a "Terms of Use Agreement" printed on an outside surface of the envelope. When he or she tears open the envelope, an indication may be generated and recorded as an acceptance of the Terms of Use Agreement by the customer.

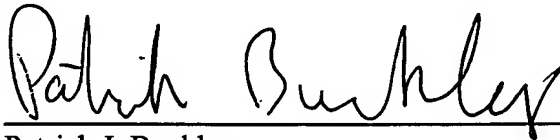
As best understood by Applicants, US Patent No. 6,578,199 ("Tsou") discloses that software program usage may be monitored to determine whether or not an agreement is being violated (e.g., an agreement to use the program on only a limited number of computers). Applicants respectfully suggest that the Office Action does not attempt to provide a motivation to combine Tuttle and Tsou (only that the combination would be "obvious"). Because there is no motivation to combine these references, Applicants respectfully request allowance of these claims.

CONCLUSION

Claim 52 includes many of the limitations described herein. Applicants' silence with respect to other statements made in the Office Action does not imply agreement with those statements.

Applicants respectfully request allowance of the pending claims. If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is kindly invited to contact the undersigned via telephone at (203) 972-0191.

Respectfully submitted,

A handwritten signature in cursive script, reading "Patrick Buckley", written in dark ink over a horizontal line.

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